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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,195	06/22/2006	Peter Hildebrand	BEET-13	8405
26875 7590 06/24/2009 WOOD, HERRON & EVANS, LLP 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202				
EXAMINER				
EVANS, GEOFFREY S				
ART UNIT		PAPER NUMBER		
3742				
MAIL DATE		DELIVERY MODE		
06/24/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/552,195

**Applicant(s)**

HILDEBRAND ET AL.

**Examiner**

Geoffrey S. Evans

**Art Unit**

3742

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 and 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)  
Paper No(s)/Mail Date 20051006, 20080911
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### DETAILED ACTION

1. Claims 9-17 and 21-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 13 April 2009.
2. The drawings are objected to because in figure 3 elements 35,36,37, and 38 require labeling (see 37 CFR 1.83(a)). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1,2,3,8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wrba et al. in WO 00/18535 in view of Opdyke in U.S. Patent No. 5,331,131. Wrba et al. teach laser machining a mold. Opdyke teaches that laser ablation creates debris (swage) and Opdyke teaches scanning over the entire surface of the workpiece including side walls in a specified manner to reduce the debris (swage). It would have been obvious to adapt Wrba et al. in view of Opdyke to provide this to reduce the amount of swage(debris) on the workpiece. Regarding claim 3, it would be well within the level of ordinary skill in the art to determine how often this scanning treatment is necessary, hence it is considered obvious in the absence of evidence of unexpected results.

6. Claims 4,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wrba et al. in WO 00/18535 in view of Opdyke as applied to claims 1 and 18 above, and further in view of Sako et al. in Japan patent No. 11-170,077. Sako et al. teach using a defocused laser beam to minimize sticking of dross (swage). It would have been obvious to adapt Wrba et al. in view of Opdyke and Sako et al. to provide this to minimize sticking of the swage during the scanning step as taught by Opdyke. Regarding claim 20, defocusing the beam is functionally equivalent to reducing the laser beam power.
7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wrba et al. in view of Opdyke as applied to claim 1 above, and further in view of Kono et al. in Japan Patent No. 7-9171. Kono et al. teaches sending a laser beam at an angle to the surface. It would have been obvious to adapt Wrba et al. in view of Opdyke and Kono et al. to provide this for the beam to reach parts of the surface that are hard to reach with the laser beam only passing through the vertical direction.
8. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wrba et al. in view of Opdyke as applied to claim 1 above, and further in view of Bestenlehrer in U.S. patent No. 6,043,452. Bestenlehrer teaches measuring the contour of a workpiece before laser processing and using a control device (element 6) to automatically control the process. It would have been obvious to adapt Wrba et al. in view of Opdyke and Bestenlehrer to provide this to determine where the swage is located on the workpiece and to automate the process so that constant supervision by a human operator of the device is not required.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Williams in U.S. patent No. 6,407,361 discloses laser engraving.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S. Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 7:30AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu Hoang can be reached on (571)-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey S Evans/

Primary Examiner, Art Unit 3742